

REMARKS

The Office Action of July 9, 2003, has been reviewed, and in view of the foregoing amendments and following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested.

Claim Objections

Claims 24 and 29 have been amended to change the second occurrence of “market information” to “the market information.” No new matter has been entered. These amendments are believed to overcome the claim objections of claims 24 and 29.

Claim Rejections - 35 U.S.C. 103

Claims 10 and 20 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Imprinted Products** (a collection of articles U, V, W, X, 2U, 2V and 2W) and **Official Notice** (ON1) in view of **Archive** (a collection of Promomart.com web pages 2X) further in view of **Online Auctions** (a collection of articles 3U, 3V, 3W, and 3X). The Examiner has applied a total of 13 articles to reject independent claims 10 and 20.

The Examiner applies the collection of articles U, V, W, X, 2U, 2V and 2W as the category of **Imprinted Products**.

Article U appears to be directed to an online mall offered by Gateway referred to as logomall.com.

Article V appears to be directed to PromoMart web site.

Article W appears to be directed to PromoMart.

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Article X appears to be a general article discussing corporate gift giving with mention of PromoMart.

Article 2U appears to be directed to picture mall (www.pix.com).

Article 2V appears to be directed to picture mall (www.picturemall.com).

Article 2W appears to be directed to picturemall.com.

At best, the collection of seven Imprinted Products articles refers to three separate and distinct systems (1) Logomall.com (*U*); (2) PromoMart (*V, W, X*); and (3) picture mall (*2U, 2V, 2W*).

The Examiner applies the collection of articles 3U, 3V, 3W, and 3X as the category of **Online Auctions**.

Article 3U appears to be directed to FreeMarkets online.

Article 3V appears to be directed to a general article discussing Internet auction sites.

Article 3W appears to be directed to eBay.

Article 3X appears to be directed to OpenSite Auction.

At best, the collection of four Online Auctions articles refer to three separate and distinct systems (1) FreeMarkets online (*3U*); (2) eBay (*3W*); and (3) OpenSite Auction (*3X*).

In actuality, the Examiner has rejected independent claims 10 and 20 over **three systems under the category of Imprinted Products and Official Notice**, in view of **Archive**, further in view of **three systems under the category of Online Auctions**. Therefore, independent claims 10 and 20 have been rejected over at least eight separate references. The fact that the Examiner found it necessary to combine at least eight separate references in an attempt to overcome

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independent claims 10 and 20 is clear evidence that such an attenuated rejection is based purely on hindsight and is therefore improper.

Claims 21, 23, 25, 26, 28 and 30 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Imprinted Products (a collection of articles U, V, W, X, 2U, 2V and 2W) and Official Notice (ON1) in view of Archive (a collection of Promomart.com web pages (2X) further in view of Online Auctions (a collection of articles 3U, 3V, 3W, and 3X) and *further in view of Dell Computer (a collection of articles 4U, 4V and U.S. Patent No. 6,167,383)*.

In addition to the eight reference combination, the Examiner further applies two articles that appear to be directed to Dell Computers and U.S. Patent No. 6,167,383 (“the ‘383 patent”) that is assigned to Dell USA, LP. The ‘383 patent is a separate reference and cannot be combined under the category of Dell Computer merely because the ‘383 patent is assigned to Dell USA, LP. The scope and purpose of the ‘383 patent is different and separate from the articles of 4U and 4V and cannot be combined as a single reference. Thus, this combination of references is improper. Claims 21, 23, 25, 26, 28 and 30 are rejected over the eight reference combination discussed above and further in view of the Dell articles and the ‘383 patent, for a total of at least a ten separate references.

Claims 22 and 27 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Imprinted Products (a collection of articles U, V, W, X, 2U, 2V and 2W) and Official Notice (ON1) in view of Archive (a collection of Promomart.com web pages (2X) further in view of Online Auctions (a collection of articles 3U, 3V, 3W, and 3X) and further in

view of Dell Computer (a collection of articles 4U, 4V and U.S. Patent No. 6,167,383) *and further in view of Green et al (4W) and Official Notice (ON2)*.

In addition to the ten reference combination applied above, the Examiner combines another article and official notice to meet the limitations of claims 22 and 27. The mere fact that at least *twelve references* are necessary to obviate claims 22 and 27 is a clear indication that these claims are patentable and not obvious.

Claims 24 and 29 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Imprinted Products (a collection of articles U, V, W, X, 2U, 2V and 2W) and Official Notice (ON1) in view of Archive (a collection of Promomart.com web pages (2X) further in view of Online Auctions (a collection of articles 3U, 3V, 3W, and 3X) and further in view of Dell Computer (a collection of articles 4U, 4V) and U.S. Patent No. 6,167,383 *and further in view of Maloney (4X)*.

In addition to the ten reference combination applied above, the Examiner combines another article to meet the limitations of claims 24 and 29. The mere fact that at least *eleven references* are necessary to obviate claims 24 and 29 is a clear indication that these claims are patentable and not obvious.

Despite the improper combination of numerous articles and patents, the rejections of the claims are improper for failing to provide proper motivation. It is clear that the Examiner has collected an unreasonably large number of references for no real purpose or goal and has based any alleged motivation on pure hindsight. Even if these eight to twelve references could be

properly combined, the combination nevertheless fails to teach each and every claim limitation and is therefore improper.

According to an embodiment of the present inventions, a system and method provide for an exchange platform that offers scaling opportunities and economies not available in the traditional business model. An online industry standard pipeline for data and order flow manages the production and distribution process from beginning to end. An embodiment of the present inventions offers a selection of high value, high quality promotional products available online where the process of selection, pricing, ordering and branding of merchandise is facilitated. An embodiment of the present inventions provides customers with an easy, efficient method of purchasing branded promotional products online where customers may browse through a set of products of interest. The customer's logo and artwork may be securely maintained in a readily available personal or corporate online library. Customers are also provided with the ability to view their firms' logo applied directly to the products selected. The production and delivery of orders online may be tracked by an embodiment of the present inventions where the customer is given access to the order status on demand. In addition, reminders for recurring events may be sent to the customer. An embodiment of the present invention may also create custom web pages for corporate clients to manage their branding program and products.

In rejecting claims 10 and 20, the Examiner applies the category of Imprinted Products (which discloses three separate systems). The Examiner then applies Official Notice (ON1) and asserts that it is well known to one of ordinary skill in the art to store the uploaded customer

information containing imprinted graphics, text, logos and/or photos into a database (page 6 of Office Action mailed July 9, 2003). However, the Examiner fails to provide any statement of motivation that would lead one of ordinary skill in the art to modify the systems of Imprinted Products. For at least this deficiency, the rejection is improper.

Recognizing the deficiencies of the systems of Imprinted Products and Official Notice, the Examiner proceeds to apply a collection of web pages under the category of Archive. The Examiner states that Imprinted Products and ON1 “do not disclose the actual web pages from the PromoMart promotional products web site to disclose the scope of PromoMart’s web-based commerce services” (page 6 of Office Action mailed July 9, 2003) and lists various features of the web site. However, the Examiner fails to discuss how any of the listed features obviate the claim limitations of independent claim 10 and 20. Further, the Examiner relies on an alleged motivation of “to better understand the scope of web-based commerce services provided by PromoMart, and thereby attract more buyers and promotional products industry companies to the site” (page 7 of Office Action mailed July 9, 2003). This alleged statement of motivation is not found in any teaching reference and is therefore improperly applied.

Further recognizing the deficiencies of the systems of Imprinted Products, ON1 and Archive, the Examiner proceeds to apply a collection of systems under Online Auctions. The Online Auctions at best provide a teaching directed to online auctions in general but fail to teach one of ordinary skill in the art to modify the combination of the systems of Imprinted Products, ON1 and Archive to include a bidding module for enabling at least one or more resellers or customers to present at least one order and enabling at least one vendor to bid on the presented

order wherein the at least one order is related to the plurality of branded promotional products, as recited by the claims.

Of particular importance is the lack of any demonstration of how the combination of claim limitations are met by the combination of references. More specifically, the Examiner has failed to show how the combination of references make obvious a system and method “for acquiring branded promotional products comprising: a database containing product information wherein the product information comprises product data and imprinting data related to a plurality of branded promotional products; a products web page where a customer or a reseller accesses the products web page to acquire at least one branded promotional products; a reseller showcase web page where a customer accesses the reseller showcase web page to acquire at least one branded promotional products; a vendor showcase web page where a reseller accesses the vendor showcase web page to acquire at least one branded promotional products; a front office module for providing purchase order information and marketing information and receiving at least one order from one or more resellers or customers wherein the at least one order is related to the plurality of branded promotional products; a bidding module for enabling at least one or more resellers or customers to present at least one order and enabling at least one vendor to bid on the presented order wherein the at least one order is related to the plurality of branded promotional products; an artwork library for storing customer’s logo and branding artwork associated with the plurality of branded promotional products; and a processor for processing orders received from the front office module.” This combination of claim limitations is simply not shown or discussed anywhere in any of the combinations asserted by the Examiner. It is clear that the

Examiner has failed to consider the combination of claim limitations in rejecting these claims.

Independent claims 21 and 25 are allegedly rejected under 35 U.S.C. 103(a) as being unpatentable over three systems allegedly directed to Imprinted Products and Official Notice, in view of Archive, further in view of three systems allegedly directed to Online Auctions and further in view of the Dell Computer articles and the '383 patent. For independent claims 21 and 25, the Examiner has offered a combination of at least 10 references. For the reasons state above and for the additional reasons stated below, the combination fails to provide proper statements of motivation and is therefore improperly combined.

The rejection over three systems under the category of Imprinted Products and Official Notice, in view of Archive, further in view of three systems under the category of Online Auctions is a classic example of hindsight reconstruction that is contrary to the law. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) ("[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references."). Here, the Office Action combines at least eight disparate references, each of which are directed to different goals, to allegedly yield independent claims 10 and 20. For independent claims 21 and 25, the Office Action combines at least ten disparate references, each of which are directed to different goals, to allegedly yield the

independent claims.

The Office has failed to set forth a *prima facie* case of obviousness for the independent claims. Additionally, it does not even attempt to establish a *prima facie* case of obviousness for the further modifications proposed to yield the dependent claims either. Furthermore, the fact that at least eight disparate references are needed in combination to address Applicant's claimed invention further supports a clear finding of non-obviousness.

Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for modifying three systems under the category of Imprinted Products as allegedly taught by Official Notice, Archive and the three systems under the category of Online Auctions has absolutely nothing to do with the deficiencies of the three systems allegedly directed to Imprinted Products. To properly modify the three systems under the category of Imprinted Products to correct for these major deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with the three systems under the category of Imprinted Products. Any such motivation is completely lacking.

Accordingly, the Office has failed to provide any proper motivation for modifying the three systems under the category of Imprinted Products and Official Notice, in view of Archive, further in view of three systems under the category of Online Auctions, so the proposed combination fails. Even if these disparate references could be combined, the resulting combination fails to show each and every limitation claimed by Applicant.

The Office Action fails to show any motivation as to why one of ordinary skill in the art would have been motivated to combine the three systems under the category of Imprinted Products and Official Notice, in view of Archive, further in view of three systems under the category of Online Auctions. The mere fact that at least eight separate disclosures can be combined or modified does not render the resultant combination or modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See M.P.E.P § 2143.01; see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The remaining claims depend ultimately from independent claims 21 and 26 and, as such, contain the features recited in claims 21 and 26. As discussed above, three systems under the category of Imprinted Products and Official Notice, in view of Archive, further in view of three systems under the category of Online Auctions and further in view of Dell Computer articles and the '383 patent fail to suggest or disclose each feature recited in claims 21 and 26 and, therefore,

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also fails to suggest or disclose at least these same features in the dependent claims 22-25 and 27-30. For at least this reason applicant respectfully submits that the rejections of claims 22-25 and 27-30 are improper and request that they be withdrawn.

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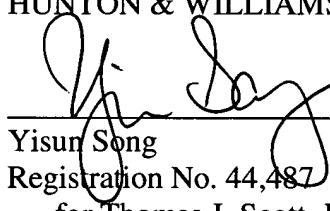
CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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